[illegible]

October Term, 1915

The Chesapeake Corporation of Virginia,
Appellant,

v.

The Standard Coach and Chassis
Manufacturing Company,
Respondent-Appellee.

Brief for Appellee

Harry W. Van Dyke,
Attorney for Appellee,

Address: [illegible]
Of Counsel.

[illegible]

CONTENTS.

	Page
STATEMENT OF THE CASE	1
ARGUMENT	9
POINT I.—This Court is without jurisdiction to review the decision below in the case at bar	9
POINT II.—Neither of the two counts of the complaint in the case at bar presents a case of violation of plaintiff's rights in a trade-mark. The first count is based on an alleged infringement, not of a trade-mark, but of a trade-name, as to which no infringement has been shown. The second count is based on allegations of unfair competition.	13
POINT III.—The defendant is not shown to have been guilty, and was not in fact or law guilty, of unfair competition	24
CONCLUSION	43

AUTHORITIES CITED.

Page

Liggett & Meyer Tobacco Co. v. *Finzer*, 128 U. S. 182 14
Baxter v. *Zuazua*, 5 P. R. 162, 163 ..... 15, 21, 39
38 Cyc., 678, 693, 695, 769 ..... 18, 19
Yuchausti & Co. v. *Song Fo Co.*, 21 P. R. 283 ..... 22, 23
U. S. v. *Manual*, 7 P. R. 221 27
D. & H. Canal Co. v. *Clark*, 20 L. Ed. U. S. 581 35
Hygeia Distilled Water Co. v. *Hygeia Ice Co.*, 72 Conn. 64 35
Ill. Watch Case Co. v. *Elgin Nat. Watch Co.*, 94 Fed. R. 667 35
Morgan Envelope Co. v. *Walton*, 86 Fed. R. 605 35
Brown Chemical Co. v. *Meyer*, 35 L. Ed. U. S. 247 35
Laughman's Appeal, 128 Pa. 1 35
Hoyt v. *Lovett*, 31 L. R. A., 44 35
Coffman v. *Costner*, 178 U. S. 168 35
Evans v. *Vanlaer*, 32 Fed. R. 153 35
N. Y. & R. Cement Co. v. *Copley Cement Co.*, 45 Fed. R. 212 35
Blackwell v. *Wright*, 73 N. C. 312 35
Elgin Butter Co. v. *Elgin Creamery Butter Co.*, 155 Ill. 157 ..... 35, 40
Pillsbury-Washburn Flour Mills Co. v. *Eagle*, 41 L. R. A. 462 36
French Republic v. *Saratoga Vichy Spring*, 48 L. Ed., U. S. 247 36
Gage-Downs Co. v. *Featherbone Corset Co.*, 83 Fed. 213 36
Joseph v. *Macowski*, 97 Cal. 518 38
Manhattan Medicine Co. v. *Wand*, 27 L. Ed., U. S. 706 38
Connell v. *Reed*, 128 Mass. 477 38
American Cereal Co. v. *Pettijohn Cereal Co.*, 72 Fed. R. 903 38
Prince Mfg. Co. v. *Prince Met. P. Co.*, 135 N. Y. 24 38
Ubeda v. *Zialcita*, 13 P. R., 11 39
Kellar v. *Sanders*, 122 N. Y. 65 39
Keely v. *Hargreaves*, 236 Ill. 316 39
Fox v. *Glynn*, 191 Mass., 344 39
Am. Wire Co. v. *Kohlman*, 158 Fed. R. 830 40
Daviess Dist. Co. v. *Martinoni*, 117 Fed. R. 186 41
Hazleton Boiler Co. v. *Hazleton Tripod Co.*, 142 Ill., 494 41
Cohen v. *Nagle*, 190 Mass., 4 42
Waltham Watch Co. v. *U. S. Watch Co.*, 173 Mass. 85 42
Higgins Co. v. *Higgins Soap Co.*, 144 N. Y. 462 42
Singer Mfg. Co. v. *June Mfg. Co.*, 163 U. S. 169 42

In the Supreme Court of the United States.

OCTOBER TERM, 1918.

THE COMPANIA GENERAL DE TABACOS DE FILIPINAS, *Appellant*,

v.

THE ALHAMBRA CIGAR AND CIGARETTE MANUFACTURING COMPANY.

No. 180.

An Appeal from the Supreme Court of the Philippine Islands.

BRIEF FOR THE APPELLEE.

STATEMENT OF THE CASE.

This case comes to this Court on appeal from the Supreme Court of the Philippine Islands. The complaint of the Compania General de Tabacos de Filipinas, a Philippine cigar and cigarette manufacturing concern that also was engaged in the business of buying and exporting tobacco, copra, hemp, and other products of the country (R., p. 20), was filed in the Court of First Instance of the city of Manila the 30th of July, 1914 (R., p. 1).

It is in two counts. In both it is alleged that the plaintiff and defendant are corporations, the former organized

under the laws of Spain, duly licensed for the transaction of business in the Philippines, the latter organized under the laws of the Philippine Islands. In both counts it is further alleged that plaintiff was, at the time of filing the complaint, and for more than 27 years had been engaged in the business of manufacturing, and marketing throughout the world, cigars and cigarettes, and for that purpose operated a factory known as "*La Flor de la Isabela,*" which designation had been generally and continuously used on the packages and containers of its products.

In both counts it was further alleged that on the 5th of April, 1887, a certificate of registration and ownership of the phrase "*La Flor de la Isabela*" was granted by the Spanish authorities then having jurisdiction in the Philippines, and that said certificate has never been annulled; that the phrase in question was intended originally to refer to one of the provinces in the Philippine Islands ("La Isabela") but that, because of its long-continued and extensive use by plaintiff in connection with the products of the factory mentioned, various abbreviations, including the word "Isabela," had acquired a secondary meaning indicating that the manufactures relative to which it was used were the products of the factory mentioned.

It was further alleged in both counts that on or about the 1st of June, 1914 (about two months before this suit was brought), the defendant "wrongfully and unlawfully appropriated to its own use the word 'Isabelas' in its

secondary meaning and as a distinguishing brand or name of its tobacco products" and that, since said date, the defendant "has been, and now is, engaged in manufacturing, packing, marketing and offering for sale, in the city of Manila and elsewhere in the Philippine Islands, packages of cigarettes under the name and style of 'Isabelas,' and upon which said packages, in addition to the lawful statement that the contents thereof are manufactured from the tobacco of La Isabela Province, the said defendant has caused to appear, in prominent characters, the name 'Isabelas' as the distinguishing brand or name thereof."

At this point the counts diverge. In the first count it is further alleged that such "use of the name 'Isabelas' is calculated to deceive the public into the belief that the goods of the defendant so designated and branded are the goods manufactured or dealt in by this plaintiff;" that such "use will cause the said plaintiff continuous, irreparable and immeasurable injury," and "that, unless restrained and prohibited by the order of this court, the defendant will continue in the unlawful use and employment of said brand or name to the injury of plaintiff as aforesaid."

In the second count it is alleged, in addition to the matter above stated, that "under and in pursuance of the general acceptance of the term 'Isabelas,' as the designation of the products of the factory of this plaintiff, the said plaintiff has adopted and appropriated the

said word 'Isabelas' as a distinguishing brand or name, and, during more than twenty years last past, has been manufacturing * * * and offering for sale certain cigarettes under the name and style of 'Isabelas;' that by reason of the facts aforesaid, the word 'Isabelas' * * * has come to be, and is, the name by which the said cigarettes * * * are usually and generally known and designated."

Then, after repeating the above-stated allegations of the first count with respect to wrongful and unlawful appropriation and use of the word by the defendant, and after alleging that such use was "for the purpose of deceiving the public" and (this in addition to the allegation in the first count) for the purpose of "defrauding this plaintiff of the legitimate trade of the latter," plaintiff prays for a preliminary injunction, to be made permanent in final hearing of the case, and for an accounting and order requiring the defendant to pay to plaintiff double the amount of any profits that may be found to have been realized from the sale by the defendant of any of its cigarettes bearing the name "Isabelas." (R., pp. 1–6.)

For answer the defendant denied all the allegations of both counts, except paragraphs 1 and 2, in which the corporate organization and existence of the parties is alleged. (R., p. 7.)

On the 3rd of August, 1914, the hearing of the case was begun in the Court of First Instance (R., p. 7). On the

24th of August, 1914, the Court announced its decision. "We doubt," said the Court, "that the facts established, under the circumstances of the case, justify the inference of actual intent on defendant's part to deceive the public and defraud a competitor and can, therefore, not find the defendant guilty of unfair competition. The case is rather one of the violation of a trade-mark under the first four sections of Act No. 666 * * *.

"Section 4 of the Act provides that in order to justify recovery for its infringement, registration of the trade-mark need not be known. 'It shall be sufficient to invoke protection of his property in a trade-mark if the party complaining shall prove that he has used the trade-mark claimed by him upon his goods a sufficient length of time so that the use of the trade-mark by another would be an injury to him and calculated to deceive the public into the belief that the goods of that other were the manufactured or dealt in by the complaining party.'" That being the law as to trade-marks, and having held that the facts essential to its application in the case at bar had been proven, the Court granted the injunction, accounting, etc., in accordance with plaintiff's prayer (R., pp. 62–64).

Thereafter, on the 26th of August, 1914, the defendant moved that the judgment rendered be set aside and a new trial granted on the grounds, (1) that the findings of fact were plainly and manifestly against the weight of

the evidence, (2) that the evidence was insufficient to justify the decision, and (3) that the decision was contrary to law (R., p. 64). On the 29th of the same month the motion was overruled (*id*), whereupon the defendant duly noted its exception and gave notice of intention to appeal (*id*).

From the decision of the trial court of the question raised by the second court in the complaint (*i. e.*, the question as to whether or not the defendant had been guilty of unfair competition), plaintiff took no appeal. The case, therefore, went before the Supreme Court of the Islands on the one count. With respect to this, however the latter Court said:

> "Plaintiff did not appeal from that part of the judgment finding the defendant not guilty of unfair competition, while the defendant appealed from that part founded on the violation of a trade-mark and decreasing a perpetual injunction. Therefore, the question involving unfair competition is not really before us, that count of the complaint founded thereon having been in effect dismissed by the trial court and no appeal having been taken from that dismissal. While the Court founded its judgment solely on the theory of a violation of a trade-mark, and although the defendant insisted from the very beginning that the action as set out in the complaint in no possible way involved the question of a trade-mark, nevertheless the Court, as we have seen, proceeded to try and resolve the case on that theory and based its judgment exclusively thereon.

"Defendant now contends that if it appears that the action was not for a violation of a trade-mark, the judgment should be reversed, as it was wholly mislead in its defence and would be seriously prejudiced by the change necessarily resulting. We regard the action, however, as we necessarily must under the statute, as one for the violation of a trade name and not one for the violation of a trade-mark or for unfair competition; but, inasmuch as we find for the defendant on the whole case and reverse the judgment against it, we do not stop to dispose of the question as to whether the theory of the action was changed during or after trial or on appeal so long as the parties have agreed on certain questions which they have submitted and discussed, which questions include all those which can arise whether the action be for a trade name or unfair competition. We prefer to decide the case so as to end the litigation once for all.

"Inasmuch as the plaintiff did not appeal from the judgment dismissing the complaint as to unfair competition, we would be justified in holding that that question is not before us and accordingly in deciding the case from the single viewpoint of a violation of a trade name (not trade-mark); but for the reasons just expressed, we take up both alleged causes of action and decide all the questions presented by both. Plaintiff's claim is this: it has trade-name rights in the word 'Isabela.' The defendant has violated those rights. Plaintiff is entitled to damages on the theory of a violation of a trade name or unfair competition

> or both. Can it recover? We hold that none of these claims have been sustained and that plaintiff is not entitled to recover on any theory mentioned. We proceed to show why." (R., pp. 65–66.)

The decision of the Supreme Court of the Islands, from the opinion in support of which the above is quoted, was rendered the 10th of February, 1916 (R., p. 64). On the 22d of January, 1917, plaintiff petitioned for the allowance of appeal and submitted therewith its assignment of errors (R., pp. 75, 76). On the 24th of the same month the appeal was allowed (R., p. 78). On the 25th bond was filed (R., p. 79) and on the 27th of the same month citation was duly served on the attorneys for the defendant. (R., p. 80.)

ARGUMENT.

POINT I.

THIS COURT IS WITHOUT JURISDICTION TO REVIEW THE DECISION OF THE COURT BELOW IN THE CASE AT BAR.

In its petition for the allowance of an appeal to this Court in the case at bar, plaintiff stated, as the ground on which this Court was believed to have jurisdiction to review the decision of the Supreme Court of the Islands, that the "action is one in which is involved the treaty of the United States with the Kingdom of Spain, executed at Paris on the 10th day of December, 1898, wherein it is provided that the property rights of private establishments or associations having legal capacity to acquire and possess property, and especially the rights of property secured by copyrights and patents acquired by Spaniards in the Philippine Islands at the time of the ratification of said treaty, shall not be impaired."

It is respectfully submitted that in this case the treaty referred to is not involved in any such sense as to give this Court jurisdiction. Section 248 of the Judicial Code—which counsel for plaintiff admits, in the brief filed by him in this Court in the case at bar (p. 11) contains the jurisdiction provision that governs the present appeal, the amendment of September 6th, 1916, having been approved after the decision of the Supreme Court of the Islands was rendered—reads as follows: "The Supreme Court of the United States shall have jurisdiction to review * * *

the final judgments and decrees of the Supreme Court of the Philippine Islands in all actions * * * in which the Constitution, or any statute, treaty, title, right or privilege of the United States is involved," etc.

In the case at bar no question has been raised as to the validity or interpretation or construction of the Treaty of Paris of 1898 or of any of its provisions. Nor is there any contention as to any right or title that plaintiff may have acquired by virtue of the treaty or any statute, law or privilege of the United States. The registration permitted and a grant of title that was made by the Spanish Governor and Captain-General of the Philippines on the 5th of April, 1887 (R., pp. 21, 50), states that plaintiff's manager had proved "in due form and by competent evidence that the said corporation is the sole owner and possessor of the trade names and trade-marks used by it to distinguish the products of the cigar and cigarette factory established by it in this city" (Manila), "the description of which is as follows: (1) Trade names: *La Flor de la Isabela*," etc.

Five other trade names are mentioned, but "Flor de la Isabela" is the only one which is concerned. The certificate then continues "Trade-marks: There is but one for all the products of the factory, a facismilie of which is attached, marked with the letters A and B. It consists of a shield surmounted with a mural crown, divided into four quarters, which contain, in the order in which they are mentioned, a tobacco plant, a brig on the sea with all sails set, a factory building, and several

clumps of sugar cane. In the center there is a shield bearing the arms of the city of Manila. Above and below are two ribbons bearing the name of the company, and on each side the words: 'trade-mark."'

In neither count of the complaint is it alleged that the defendant had appropriated, or made any use whatever, either of the trade name "Flor de la Isabela," or of the trade-mark described above, of any trade-mark belonging to the plaintiff. No such question was raised or contention made in the Courts below. What the complaint does allege is that the phrase "Flor de la Isabela" (or "La Flor de la Isabela," as it is stated in the complaint) had by usage acquired an abreviated form, *i. e.*, the one word "Isabela;" that by that name plaintiff's cigarettes had become known, and that, by its use of that word in connection with its own trade name ("Alhambra Isabelas") and in connection with its own trade-mark, which it was admitted bore no other similarity, the defendant was deceiving the public, etc.

Plaintiff alleged in the complaint and contended in the courts below that although the word "Isabela" was used originally to indicate that the tobacco of which the cigars and cigarettes were made was produced in the Province of Isabela, in the Island of Luzon, the word had acquired a *secondary* meaning that had reference to the manufacture of the goods *by plaintiff* and not to the locality in which the tobacco was grown. The question therefore, was not whether the plaintiff had acquired

any title or right from Spain when it had dominion over the Philippines which by virtue of the treaty could not lawfully be infringed—there was no dispute as to that—but merely whether the use of the word "Isabelas" by the defendant did or did not constitute a violation of that right.

In other words, there was no denial of, or contention with respect to, the right of the plaintiff, under the Spanish registration and by virtue of the treaty to the exclusive use of the trade-mark above described and the phrase or trade name "Flor de la Isabela." The contention was as to the use by defendant of the one word "Isabelas," in its secondary sense; and the word "Isabelas" is not even a part of the phrase "Flor de la Isabela," for in the phrase it is employed in its singular sense and the use charged to have been made of it by defendant was in the plural. Neither the interpretation or constriction of the treaty, therefore, nor the validity of any title or right secured thereunder, is in this case involved; and neither in that aspect of the case nor in any other is there any feature that could confer jurisdiction on this Court.

POINT II.

NEITHER OF THE TWO COUNTS OF THE COMPLAINT IN THE CASE AT BAR PRESENTS A CASE OF VIOLATION OF PLAINTIFF'S RIGHTS IN A TRADE-MARK. THE FIRST COUNT IS BASED ON AN ALLEGED INFRINGEMENT, NOT OF A TRADE-MARK, BUT OF A TRADE NAME, AS TO WHICH NO INFRINGMENT HAS BEEN SHOWN. THE SECOND COUNT IS BASED ON ALLEGATIONS OF UNFAIR COMPETITION.

The defendant maintains that in its first count plaintiff's complaint does not present an action for the infringement of a trade-mark, as held by the trial court, but, as the Supreme Court of the Islands held, presents an action for the violation of a trade name; that even if it be considered as an action for violation of a trade-mark, the evidence is not sufficient to prove such a cause of action, and that if there be no infringement of some specific, definite trade-mark, the order of injunction should be dissolved and the action dismissed. The second count it is clear, is intended to present a case of unfair competition.

The complaint is lacking in all the essentials of a charge of violation of a trade-mark. It neither describes nor sets forth as an exhibit any trade-mark of the plaintiff alleging it to have been imitated or used by defendant. It neither describes nor sets forth as an exhibit any trade-mark alleging the same to have been used by defendant,

and to have been an imitiation of, or to bear any resemblance to any trade-mark of the plaintiff. Nothing has been presented by the complaint to the Court, for the Court to inspect, compare and determine whether there has been any unlawful imitation, or whether there exists any deceptive resemblance between plaintiff's trade-mark and defendant's trade-mark. *No trade-mark of any description has been made an issue in the case at bar*, and therefore cannot be decided by the law regulating and applicable to the violation of trade-marks. (Act No. 666 of the Philippine Commission, Secs. 5–9.)

Again, defendant has, in truth, made use of no trade-mark bearing any resemblance to any trade-mark of the plaintiff by which the public may possibly be deceived or the plaintiff defrauded. The defendant has in no case, and in no manner attempted so to clothe its merchandise as to resemble that of plaintiff, nor to pass off its goods upon the public as the goods of the plaintiff, and nothing it has done would tend toward that result. The trade-marks used by plaintiff and defendant are wholly different and distinct, and bear not the least resemblance to each other. (See the original exhibits sent up with record in the case.)

The best proof of the violation of a trade-mark is a comparison of the two trade-marks put at issue by a proper and sufficient complaint.

In Liggett & Meyer Tobacco Co. v. Finzer, (128, U. S., 182, Quoted in 13 P. R., 149) the Court said:

> "The judgment of the eye upon the two is more satisfactory than evidence from any other source as to the possibility of parties being misled so as to take one tobacco for the other."

In Baxter et al v. Zuazua et al, (5 P. R. 163) the court said:

> "The alleged similarity or resemblance between the labels is a question of fact which can be decided by a mere inspection of the same."

In the case at bar, the plaintiff does not pretend there exists any resemblance between the trade-marks of the parties to the case, except that resulting from the pronunciation of the word "Isabelas." Plaintiff claims only an exclusive right to the *sound* produced when the word "Isabelas" is uttered. Arguing its case as one of "unfair competition," the plaintiff in its brief filed in the Court of First Instance, (page 14) says:

> "There are different methods of deceiving the consuming public as has often been pointed out. The imitation of general appearance deceives the eye; but the public may be deceived through its sense of *hearing* as well as through its sense of sight. That a person who has seen and has once identified the packages of both plaintiff and defendant will not mistake one for the other, is no defense; it merely proves that the unfair competition of defendant *does not consist* of an imitation of the general appearance of the plaintiff's package. The gist of the

> *unfair competition* here, is that defined in the adoption of a term which has become identified with plaintiff's products and indicates falsely that the so-called "Isabela" cigarettes are the products of the plaintiff's factory..... The essential fact is that confusion results from the use by the defendant of a name so closely identified with plaintiff's wares."

This quotation should make unmistakably clear four points of the present controversy; first, what the defendant is now trying to present, to wit: that there is presented to the eye no similarity, deceptive or otherwise, on a comparison of any of the trade-marks of the litigating parties; second, that there is no ground for any action for a violation of a trade-mark; third, that there was no intention on the part of the plaintiff to present a complaint for the violation of a trade-mark; and fourth that the action can justly be considered as nothing more than an action for unfair competition based upon Act 666.

The Court of First Instance in its Decision, says:

> "That about June 15th of this year, the defendant began to manufacture and offer for sale a cigarette styled "Isabelas," the labels of the packages in addition to that name also containing the name "Alhambra" in large type; and that there is otherwise no misleading resemblance of the packages and labels to those of the plaintiff."

The Court could, with equal accuracy, have added that *defendant's* label was in fact a trade-mark duly registered in the Division of Archives of the Philippine Islands; that it was formed of two wide golden bands between which was a dark blue band of equal width, and that there was imprinted thereon a crown and shield and the words "*Alhambra* Isabelas" in large letters, and in equally distinct letters the following "*30 cigarrilols de calidad superior.—Hechos puramente con hojas escogidas de la Isabela, garantizados por Alhambra Cigar & Cigarette Manufacturing Company, Manila,* (R., p. 60) all of which, *in its entirety,* constitutes a single emblem and device—a completed trade-mark which was applied to a number of cigarettes in the form of a package wrapper. A full description of this trade-mark, and an ocular inspection of the same will demonstrate that it *is not an imitation of any trade-mark ever used by plaintiff* and that it is "not calculated to deceive the public into the belief that the goods of the defendant are the goods manufactured or dealt in by the complaining party." It will demonstrate further that defendant, in the use of this particular trade-mark, has not used the word "Isabelas" as a distinguishing brand or name for cigarettes, but that it has used a *distinctive, specific* and *complete symbol* for its brand, of which the word "Isabelas" is but a small and insignificant part.

A closer analysis of the finding just quoted will show that the Court has not found expressly that the use of the word "Isabelas" with the addition of the word "Alhambra" in large type on defendant's label forms or creates any misleading resemblance of its packages or labels to those of the plaintiff. Such a finding is deduced only by a possible inference. The defendant has not used alone the word Isabelas, but an emblem made of many figures, words, colors and devices, arranged in a distinctive manner, the whole forming in itself an entity.

A trade-mark is a name, embelm, sign or device employed to designate the goods dealt in or manufactured by a person for the purpose of enabling the public to recognize such goods and to distinguish them from the goods or manufactures of another. (See Act. 666, Sec. 1.)

In Vol. 38, Cyc. 678, a trade-mark is defined thus:

> "A trade-mark may be defined as a name, sign, symbol, or device which is *attached to goods* offered for sale in the market so as to distinguish them from similar goods, and to identify them with a particular trader, or with his successor, as owners of a particular business, as being made, worked upon, imported, selected, certified or sold by him or them. It has been aptly described as the commercial substitute for ones own autographic signature, certifying to the genuineness of *the goods to which it is affixed.*"
>
> "The sole office or function of a trade-mark is to indicate the origin or ownership of the goods to

which it is *affixed* and *thus* to distinguish the goods of one person from those of another."

In the same Vol. 38, Cyc., page 693, it is said:

"In order to become a valid trade-mark, the name or mark must be in some way *physically attached* to the goods, and *go with them into the market.* Used only as a name or sign upon a place of business or in advertisements, circulars and other similar ways, without being actually affixed to the goods is insufficient to constitute the marks so used valid trade-mark. It is sufficient, however, if the mark is *affixed* either upon the goods, themselves, or upon the package or wrapper containing them or in any other way *physically attached* to the goods."

In 38 Cyc., page 695, it is said:

"Any word, mark or device used for the primary purpose of identifying *specific* goods as being of a definite origin or ownership may constitute a valid trade-mark, if *adopted and used as such, provided* they are such as may be exclusively appropriated without prejudice to the rights of others. No sign, or mark, or form of words can be appropriated as an exclusive trade-mark which from the fact conveyed by its primary meaning others may employ with equal truth and equal right for the same purpose; moreover, a trade-mark must consist of some *definite* word, sign or device."

It may be seen from the definition of a trade-mark and from a comprehension of its uses, that a trade-mark is a

definite, specific, exact, complete, tangible and visible thing, that may be examined and compared, and attached to goods for the purpose of identifying them, and which remains affixed to the merchandise and goes with it into the hands of the consumer. If we once understand the meaning and uses of a trade-mark we must see inevitably that no *secondary meaning* of any word can be reduced to any form or be imprinted upon any label so that it can be affixed to a package of merchandise. *A word in its secondary meaning can not be the subject of a trade-mark.* So to contend is absurd.

Yet this is the absurdity the plaintiff asked the Supreme Court below to adopt and confirm as the consummate wisdom of the Philippines. A single word may be so formed and impressed upon a label as to constitute a valid trade-mark. But the secondary meaning of that word can in no way be portrayed or made to adhere to the label. Every trade-mark is exactly what it appears to be to the eye and no more. There words are used in their primary sense alone. They import no wonderful imaginary concept. The use of a word in its secondary sense as a trade-mark is an impossibility.

Upon the trade-mark of the defendant—though this is not true of the trade-mark of the plaintiff, in which, not the single word "Isabela," but the phrase "La Flor de la Isabela," is used (R., pp. 24–5)—the words are used only in their primary sense. In the defendant's trade-

mark, the word "Isabela" is truthfully used to tell that the product of which the cigarettes are composed is from Isabela Province. Its sole purpose is to describe the quality of tobacco used. [S. N. 57, 65.]

The plaintiff has never used the word "Isabelas" as a trade-mark or as a brand for its wares. The most that plaintiff can legitimately claim is the right to the inscription "La Flor de la Isabela" as the name of its factory. This is not the corporate name. That is La Compania General de Tabacos de Filipinos, known in its abbreviated form, sometimes, as The Tabacalera.

A trade-mark must be considered as a whole. It is not separable. It cannot be divided into sections or separate words. Any division of it will destroy its character as a trade-mark. It is a fixed, unchanging entity, void of any double meaning. Even if plaintiff has a right to the exclusive use of the phrase "LA FLOR DE LA ISABELA," the name of its factory, it does not follow that it has an exclusive right to the use of any of the words contained in the phrase independently as a trade-mark. Parts of a trade-mark are not the trade-mark. Also having a right to use the phrase as a trade name as the name of a factory, it does not follow as a consequence that plaintiff has any legal exclusive right to use the phrase or the words composing it as a brand or trade-mark for packages of cigarettes.

Baxter et al. v. Zuazua et al., 5 P. R. 162, 164.

"This Court has said in the case of Inchausti & Co., v. Song Fo Co. 21 P. R. 282, that, "The component elements of a design are not to be considered separate and apart; we must look to the design as a whole; to the combination of those component parts.'"

Section 2 of Act. 666, provides that:

"Anyone who *produces or deals* in merchandise of any kind by actual use thereof in trade—may appropriate to his exclusive use a trade-mark, not so appropriated by another, to designate the *origin* or ownership thereof: Provided, That a designation or part of a designation which relates only to the name, quality, or description of the merchandise or geographical place of its production or origin can not be the subject of a trade-mark."

This section expressly authorizes, the use of the trademark devised by the defendant, and it denies the absolute right of the plaintiff to the word "Isabela" that it contends for.

In order for the plaintiff to establish a case against defendant for the violation of a trade-mark it would be necessary for the plaintiff to prove:

1. That he is entitled to the exclusive use of the trademark, and that the device and word or phrase selected is lawfully subject to appropriation as a trade-mark. (Act 666, Sec. 3.)

2. That plaintiff has registered or made use of, for a long time upon his goods, the specific trade-mark made an issue by the complaint. (Act. 666, Sec. 4.)

3. That the defendant has sold goods of a similar kind bearing such trade-mark, or one so closely resembling it as to be for all practical purposes of deception identical. (Act 666, Sec. 3.)

Inchausti & Co. v. Song Fo Co. 21 P. R., 283, 286.

4. That the use of the identical trade-mark by defendant would be "calculated to deceive the public into the belief that the goods of the defendant were the goods manufactured or dealt in by the plaintiff," (Act. 666, Sec. 4).

Whether the issue be one of a trade-name or a trade-mark the law requires the same class and the same completeness and certainty of proof. Plaintiff has not proven any ultimate fact necessary to establish a case for the violation of a trade-mark or a trade-name.

POINT III.

THE DEFENDANT IS NOT SHOWN TO HAVE BEEN GUILTY, AND WAS NOT IN FACT OR LAW GUILTY, OF UNFAIR COMPETITION.

Whether the action be for a violation of a trade-mark, a trade-name or for unfair competition the gist of the offense is the same in any case. The offense consists of an intentional deception of the public and a fraud upon a competitor, effected by so clothing a similar class of goods, that by their general appearance the public is thereby deceived into believing them to be the goods of the competitor while the guilty one reaps a profit from his rival's good reputation.

In Act. 666, section 7, the offense of unfair competition is defined, thus:

> "Any person who in selling his goods shall give them the general appearance of goods of another manufacturer or dealer, either in the wrapping of the packages in which they are contained or the devices or words thereon, or in any other feature of their appearance, which would be likely to influence purchasers to believe that the goods offered are those of a manufacturer or dealer other than the actual manufacturer or dealer, and who clothes the goods with such appearance for the purpose of deceiving the public and defrauding another of his legitimate trade,.....shall be guilty of unfair competition,..... This section applies in cases where

the deceiptful appearance of the goods, misleading as to origin or ownership, is effected not by means of technical trade-marks, emblems, signs, or devices, but by the *general* appearance of the package containing the goods, or by devices or words thereon, even though such packages, devices or words are not by law capable of appropriation as trade-marks; and in order that the action shall lie under this section actual intent to deceive the public and defraud a competitor shall affirmatively appear on the part of the person sought to be made liable, but such intent may be inferred from similarity in the appearance of the goods as packed or offered for sale to those of the complaining party."

Act 666, Sec. 9, contains this further provision which is peculiarly applicable to the case at bar:

"No action or suit, or criminal prosecution shall be maintained under the provisions of this chapter in any case where the violation of the trade-mark or trade-name or the unfair competition complained of has been in any way unlawful business, or with respect to any article, trade in which is unlawful, or is against public policy, or in any case where the trade-mark, trade-name, or the indicia of origin, ownership, or manufacture have been used by the complaining and injured party for the purpose of himself deceiving the public with respect to the character of the merchandise sold by him or the business or profession or occupation carried on by him."

The foregoing is the law under which the plaintiff must, if at all, establish a case of unfair competition.

Like in an action for violation of a trade-mark plaintiff is called upon to make a comparison between his goods as prepared for the market and those of the defendant, to determine whether there is in the *general appearance* of the competing articles such a likeness or resemblance as is calculated to cause the public to mistakenly buy the defendant's goods, when intending to buy the goods of plaintiff.

The similarity between the packages must be such as to deceive the *ordinary purchaser* in the *usual and ordinary course of business*. It is not enough that the examination may disclose differences in the appearance or in a design, to save the intentional imitator. Neither is it enough to entitle plaintiff to relief that there may be something of similarity discovered in some detail by the diligent searching and scrutiny of one paid and determined to find a point of resemblance. The resemblance must be apparent and calculated to deceive the consuming public. It must be a resemblance of the *goods as prepared and packed for the* market, a likeness apparent to the eye and deceptive because of its similarity, a resemblance of the *whole package* and not of some detail.

There is no unfair competition if the package as a whole bears distinguishing features, and such distinctive characteristics and such words, and marks, and devices and

coloring as to clearly identify the goods as that of the real owner. If an entity it is not calculated to deceive, there can be no unfair competition.

The Court has said in U. S. vs. Manual, 7 P. R. 221, and quoted with approval in 21 P. R. 285, that:

> "The true test of unfair competition is whether certain goods have been intentionally clothed with an appearance which is likely to deceive the ordinary purchaser exercising ordinary care, and not whether a certain limited class of purchasers with special knowledge not possessed by the ordinary purchaser could avoid mistake by the exercise of this special knowledge."

Also a true test is not whether a certain limited class of interested experts with special knowledge not possessed by the *ordinary purchaser* could by careful scrutiny discover some word (not similar in appearance or meaning), which when uttered has a sound with some elemental resemblance to some single word (not a phrase) found on the package of another.

The resemblance that the law speaks of in Act 666, and which is the basis of all unfair competition, is a *resemblance in the general appearance* of the goods as wrapped and packed ready for sale, discernible to the eye, and likely to deceive the purchaser.

There can be no grounds for unfair competition unless there be *actual intent* to deceive the public and to defraud a competitor. The goods must be clothed with such

similar general appearance for the *purpose* of deceiving and defrauding. Unless such purpose and such intent to deceive and defraud affirmatively appear from the evidence there can be no valid finding of unfair competition though it is true that—

> "Such intent may be inferred from the similarity in the appearance of the goods as packed or offered for sale to those of the complaining party." (Act 666, Sec. 7.)

And whether this action be one of unfair competition or one for the violation of a trade-mark or a trade-name the issue at last is this, whether the goods of defendant as packed for sale have such a likeness and similarity in appearance as is "calculated to deceive the public into the belief that the goods of that other were the goods manufactured or dealt in by the complaining party."

The plaintiff has failed in every point incumbent on him to prove in an action for unfair competition.

It has failed to prove any *exclusive right* to any design, label, trade-mark or wrapper for cigarettes, in any respect resembling that used by defendant.

It has failed to prove any resemblance in general appearance of any of its goods packed and offered for sale.

It has failed to prove that the ordinary purchaser could possibly be deceived by any similarity appearing upon the goods marketed by either party.

It has failed to prove any purpose or intent on the part of defendant to deceive or defraud.

It has failed to prove that it has suffered any damage.

Plaintiff claims an absolute, exclusive right to the use of the word "Isabela."

Isabela is the name of a province of the Philippines from which a superior grade of tobacco is produced. This tobacco is widely and generally known as Isabela tobacco. This tobacco is not the product of one hacienda or of one producer, but its culture is extensive and the dealers in it are numerous. Plaintiff has no monopoly of Isabela tobacco. Isabela is a geographical name and in its primary and descriptive sense it is publici juris, and all the world may use it. (R., pp. 37, 39, 45.

By the terms of section 2, Act 666, the word Isabela cannot be made a trade-mark. It is there provided:

> "That a designation or part of a designation which relates only to the name, quality or description of the merchandise, or geographical place of its production or origin cannot be the subject of a trade-mark."

It is apparent that the word Isabela could not be used exclusively as a trade-mark any more than could the words Kananga, Coffee, Sugar, Havana or Tobacco.

So also, the royal decree of Oct. 26th, 1888, referred to by this Court in vol. 5, P. R., 164, "provided that the denominations generally used in commerce for the purpose

of designating a class of goods could not be the subject of labels or trade-marks.''

No prior royal decree and no certificate of the soveringty of Spain ever gave or had the power to give the plaintiff any exclusive right to the word Isabela. The certificate of April 5th, 1887, offered in evidence by plaintiff does not give, nor purport to give plaintiff any exclusive right to the word Isabela. It pretends to give plaintiff the right to use the phrase ''La Flor de la Isabela,'' nothing more and nothing less, as a trade-name for a factory. It confers no right to the separate component parts of this phrase.

Spain had no authority to grant a title to the word Isabela. Spain had no more power to give a deed to the words of the lexicon, than to the letters of the alphabet. What Spain did not own she could not sell or give to another.

Plaintiff has never acquired title to the word ''Isabela'' for any purpose by long use. It has never used the word Isabela as a trade-mark or a trade-name. No cigarettes have ever issued from its factory wrapped and packed for sale on which the words ''Isabelas'' appeared as the distinguishing feature or mark of identification. Certainly plaintiff will claim no natural superior right.

The evidence offered in the case is insufficient to prove that the word ''Isabela'' has ever acquired a secondary meaning at the hands of plaintiff. If any secondary

meaning has attached to the word it is emphatically of a general and public character, meaning the tobacco product of Isabela Province, and this is as much *publici juris* as is the word in its primary signification. It is as much and truly so as when in using the word "Havana," we mean thereby a cigar made of Cuban tobacco.

The principal dealers in tobacco in Manila did not know plaintiff's product as Isabelas.

Plaintiff's witness, C. Hess, did not know plaintiff's product as Isabelas. Asked if given a cigar or cigarette and being told "it was an Isabela cigar or cigarette, would you have any impression from that statement as to what factory it came from?," he answered, "no, I would not have" (R., p. 11). He further declared that the people he dealt with do not generally refer to the cigars and cigarettes of the Tabacalera factory as Isabela cigars or Isabela cigarettes. The people buying cigars at wholesale did not use the abbreviation "Isabela."

Plaintiff's witness, E. E. Elser, being asked, "Is that name 'La Flor de la Isabela' ever abbreviated?," answered, "That I could not say, Mr. Cohn." (R., p. 11.) This witness labored under the false impression that the Tabalacera Company controlled the output of Isabela tobacco. (id., 13, 63, 67.)

Plaintiff's witness, T. D. Figueras, being asked, "What cigarettes do you smoke?", answered, "I smoke Tabacalera, Insular. I smoke different kinds; when I get tired I

change." (R., p. 19.) Again being asked, "Do you ever smoke Isabela cigarettes?", answered, "I smoke *Tabacalera* or *Flor de Isabela*." (id.) This witness seems to have momentarily forgotten that there was such a thing as Isabela cigarettes. Such an expert merchant, it seems, would have heard of the Tabacalera Isabelas if such were generally known.

Plaintiff's star witness,—Atonio Malvehy, Secretary of the Compañia General de Tabacos de Filipinas, who swore to the complaint and testified at the trial.

Mr. Malvehy's testimony, in essence, amounts to no more than this: that plaintiff has made and sold certain cigarettes of mixed tobaccos (R., p. 20 *et seq.*), denominated "Cortos," "Largos" and Entrelargos." That they have never had any other name, that their customers order them by the name of Isabela Costos, Isabela Largos and Isabela Entrelargos, that the name of the factory is "La Flor de la Isabela," and that this name "is used in all that refers to the factory as well as its products, it is on our letter heads, invoices, packages, etc.," he says. Plaintiff has never changed its labels from its crude old form, because that is well known and plaintiff wishes to continue it.

If all Mr. Malvehy has testified to be, for the purpose of the argument, admitted as literally true and unexaggerated, plaintiff has no ground of action against defendant. The designating names of its cigarette products

are "Cortos," "Largos" and "Entrelargos," in exactly the same sense as cigars on the market are named Perfectos, Londres Excelentes, Especiales, Bellezas, etc. None of its cigarettes have been named "Isabelas" or Isabela Isabelas.

It seems strange, too, that such dealers as W. E. Olsen, F. W. Prising, C. Piderit and J. C. Hoffmeister should not know of any general use of the word "Isabelas" to distinguish plaintiff's output of cigarette packages.

Mr. Olsen declares that plaintiff's cigarettes "are usually called for in the trade Tabacalera Cortos and Tabacalera Largos." (R., p. 30.) He says further that tobacco put up for export is usually marked with the provincial classification, as 4th Cagayan, 4th Isabela, etc. with the year. (id. p. 31.) Such is the general use of the word Isabela and it in no respect relates to or suggests any factory.

Mr. F. W. Prising, a tobacco merchant of nearly 16 years' experience in the Philippines, being asked, "Did you ever know of any cigarettes on the market here known as Isabela before those put on the market by the Alhambra?," answered, "Not by Isabela itself, Isabela Cortos and Isabela Largos, yes." (R., p. 35.) This witness testifies that the consumers know and call for plaintiff's cigarettes as *Isabela Cortos* or *Isabela Largos* or *Isabela Entrelargos* or as *Tabacalera Entrelargos*, usually "Tabacalera Entrelargos", and that if people called for "Isabelas" you would not know what they wanred without further questioning. (*Id.*, p. 36.)

John C. Hoffmeister, a tobacco merchant, resident of Manila for 18 years, testifies that he never saw and never heard of any cigarettes known as "Isabela" or "Isabelas" before the "Alhambra" put its product on the market. (R., p. 39.)

It thus appears that the merchants of Manila never knew of plaintiff's use of the word "Isabelas" as a brand, trade-mark or distinguishing name for its cigarettes. Turning from the dealers in tobacco to the consumers we find an equal ignorance on their part of any cigarettes being called "Isabela" prior to the output of the "Alhambra."

Jose McMiking had never heard of such (R. pp. 45, 46). Benito Blanco has never heard of such (R. p. 46).

Argument that plaintiff has never gained any right to the word "Isabelas" by use would be superfluous; the testimony refutes the pretention. "Isabelas" has never come to indicate or designate any of plaintiff's goods to the public. The name Isabelas has never become identified with plaintiff's cigarettes. The generally accepted use of the word Isabela is its application to the entire tobacco product of Isabela Province. To entitle plaintiff to any exclusive right to the secondary meaning of a word, it must plainly appear that plaintiff has *created* that secondary meaning, and has *adopted* and generally used it in that same secondary sense.

This proposition will not be disputed, that "as a general rule geographical terms are common property which all

may use, but which none may exclusively appropriate or acquire as absolute individual property."

Del. & H. Canal. Co. v. Clark, 20 L. Ed., U. S., 581.
Hygeia Distilled Water Co., v. Hygeia Ice Co., 72 Conn. 64.
Columbia Mill Co. v. Alcorn, 37 L. Ed., (U. S.) 1144.
Ill. Watch Case Co. v. Elgin Nat. Watch Co., 94 Fed. 667.
Morgan Envelope Co. v. Walton, 86 Fed., 605.
Brown Chemical Co. v. Meyer, 35 L. Ed. 247.

"No one can apply the name of a district or country to a well known natural product of that locality, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district or dealing in a like product coming from the district, from truthfully using the same designation."

Del. & H. Canal Co. v. Clark, 20 L. Ed. (U. S.) 581.
Laughman's appeal, 128 Pa. 1; 5 L. R. A. 599.
Hoyt v. Lovett, 31 L. R. A. 44.
Coffman v. Costner, 178 U. S., 168; 44 L. Ed. 1021.
Evans v. Vanlaer, 32 Fed., 153.
N. Y. & R. Cement Co. v. Copley Cement Co., 45 Fed. 212.
Blackwell v. Wright, 73 N. C., 312.
Elgin Butter Co. v. Elgin Creamery Co. 155 Ill. 157; 40 N. E. 616.

If plaintiff has ever used the word "Isabela" on its cigarettes, as it pretends, it has been, admittedly, in only a fanciful, arbitrary and fictitious sense. The testimony of plaintiff's manager (R., p. 26) and the finding of the Trial Court (R., p. 62) is to the effect that plaintiff *does not use Isabela tobacco in its cigarettes.* Plaintiff's factory is not located in Isabela Province, and it does not use Isabela tobacco in its cigarettes. Its pretended use is plainly deceptive and a fraud upon the public.

The right of a user of a geographical name in a fanciful sense is not the same as the rights of a user of the same word in a true descriptive sense. The law is more favorably construed and enforced in favor of the honest user, in a truely descriptive sense. The Courts will quickly protect a resident of a locality, or the honest user of a product from a locality, in the use of the local name against the use of the same name simulated by a non-resident.

See:

Pillsbury-Washburn Flour Mills Co. v. Eagle, 41 L. R. A. 462.

French Republic v. Saratoga Vichy Spring, 48 L. Ed. 247.

Gage-Downs Co. v. Featherbone Corset Co., 83 Fed. 213.

All users of geographical names as trade-marks or trade-names, adopt the same subject to the truthful and honest use of any subsequent competitor who does not inten-

tionally clothe his goods like the first for the purpose of deceiving and defrauding. It has been well said that:

> "The confusion naturally resulting from the truthful use of a geographical name by a second producer to designate a natural or manufactured product of that locality furnishes no ground for equitable relief, since to hold otherwise would be to uphold an exclusive right to the use of a name which is not the subject of exclusive appropriation. The resulting injury to the first appropriator is a penalty which he ought to suffer for chosing as his trade-mark a word which it is well settled cannot be appropriated as such."
>
> 45 L. Ed., (U. S.) 381 note.

The gravamen of unfair competition consists in the dressing up of goods by one person so as to represent them to be those of another.

> "And to constitute unfair competition by the use of a geographical name as the designation of a commodity it would seem that where it is not untruthfully used as by a resident of another place or upon a product not of such locality, such use must include the simulation of other distinguishing feature of the "dress" of the complaining manufacturer's goods, the mere use of the name alone in such cases, it is submitted, not being sufficient to satisfy the requirement which all the cases make, that it be so used as to misrepresent the origin of the product."

The affirmative distinguishing features upon defendant's

labels are markedly conspicuous and do not have to be searched for. The resembling features have to be found in the imagination; the similitude is wholly a creation of the fancy—a fantastic illusion.

Plaintiff's use of the word "Isabela" on its cigarettes is a fraud upon the public. Whether intentional or not it has led the public falsely to believe its product to have come from Isabela province.

Equity will not interfere to protect the fraudulent use of a geographical name. A mark that conveys a false impression of the origin and quality of a manufactured product will not be protected. The misrepresentation and falsity may be implied from the words used.

> Joseph v. Macowsky, 97 Cal., 518.
> Manhattan Medicine Co. v. Wand, 27 L. Ed., 706.
> Connell v. Reed, 128 Mass. 477.
> Am. Cereal Co. v. Pettijohn Ce. Co., 72 Fed., 903.
> Prince Mnfg. Co. v. Prince Met. P. Co., 135 N. Y. 24; 31 N. E. 990.

The fraudent use of the word "Habana" on a label for cigars made in Mexico was considered to defeat the manufacturer's right to register as a new mark this label with the true place of origin substituted for "Habana." Note, 45 L. Ed., 376.

Plaintiff's deceptive, misleading and fraudulent use of the word "Isabela," by which the public are deluded and defrauded, precludes it from any right to enjoin another from a truthful and honest descriptive use of the word.

Plaintiff should come into Court with a clean hand and an honest purpose, not asking the Court to aid in it perpetuating a fraud and in creating a monopoly.

Baxter v. Zuazua, 5 P. R., 160.
Ubeda v. Zialcita, 13 P. R., 11.
Keller v. Sanders, 122 N. Y., 65; 25 N. E., 235.
Keely v. Hargreaves, 236 Ill., 316.
Fox v. Glyn. 191 Mass., 344; 78 N. E., 89.

The use of the geographical designation of a locality from which the principal material of a manufactured article comes will not be enjoined where the great element of value of the manufactured article consists in the locality of the principal material of which it is composed.

Gabriel v. Sicilian Asphalt P. Co., 23 Misc. (N. Y.) 534.

In an action for unfair competition the *intent* to deceive and defraud must affirmatively appear. A purpose to defraud is the essence of unfair competition. This action rests on the theory of intentional false representation, and this is the principal distinction between an action to protect a trade-mark from infringement and an action to protect against unfair competition.

A trade-mark may be infringed innocently through accident or ignorance. Yet imitation will be enjoined and actual damage awarded. But where it is sought to enjoin the use of a geographical name by a rival on the ground of unfair competition, it must appear that such use is with the *fraudulent intent* to *deceive* the public, amounting to

a false representation as to the origin of the article with reference to which the name is used. Such a deceiptful representation must be proved by direct evidence, or be fairly inferable from the likeness of the dress and appearance of the goods when packed and branded for sale.

> Am. Wire Co. v. Kohlman, 158. Fed., 830.
> Elgin Butter Co. v. Elgin Creamery, Co., 155 Ill., 127; 40 N. E., 616.

One person has as much right to sell his goods as has another. The law does not favor monopoly or restraint of trade. It only prohibits the fraudulent "dressing up" of goods and their fraudulent sale as that of the goods of a competitor.

In the case at bar there is no affirmative proof of intent to deceive or to defraud; there is positive proof of the contrary. Intent cannot be inferred for there is an absolute and emphatic dissimilarity in the appearance of the goods as put upon the market.

In no single instance has a purchaser been deceived, nor has the goods of defendant ever been "palmed off" on the public as the goods of the plaintiff. No package of defendant's goods, bearing even a remote resemblance to those of plaintiff or calculated by any likeness of appearance to deceive, has been offered in evidence. A mistake as to the origin and identity of defendant's goods is impossible. Neither an old customer of plaintiff nor a new intending customer could be deceived. Neither a literate

nor illiterate one could be deceived by any resemblance. Deception will not be the natural nor probable result.

Plaintiff has proven neither loss nor damage, nor anticipated injury. Its damage is imaginary, speculative, conjectural and impossible.

> "Where it appeared that at the time of the adoption of such words as 'Kentucky Club Bourbon' to designate a brand of whiskey, the complainant was selling in that locality very little if any whiskey branded 'Kentucky Club,' and its product was but little known therein, and it did not show that it had lost any sales by reason of the adoption by another of a similar name, and no damage to it by the alleged invasion of private rights was shown, the elements of an action for unfair competition were wholly wanting."

Daviess Dist. Co. v. Martinoni, 117 Fed., 186.

The law is stated thus in 38 Cyc. 796:

> "Where a subsequent trader has acted honestly, and has sufficiently discharged the duty resting upon him to affirmatively distinguish his goods or business, and has made no unnecessary or untruthful use of names or marks previously identified with a rival trader, any loss or damage caused by the mere use of words or marks which are *publici juris* in their primary sense is 'dannum absque injuria' for which no action lies."

Hazelton Boiler Co. v. Hazelton Tripod Co., 142 Ill. 494; 30 N. E., 339.

Cohen v. Nagle, 190 Mass. 4; 2 L. R. A. (N. S.) 964.

Waltham Watch Co. v. U. S. Watch Co., 173 Mass., 85; 53 N. E., 141.

Higgins Co. v. Higgins Soap Co., 144 N. Y., 462; 39 N. E., 490.

Singer Mnfg. Co. v. June Mnfg. Co., 163 U. S., 169; 41 L. Ed., 118.

With whatever perspective this matter may be viewed it becomes at once apparent that plaintiff has no ground for action.

Viewed as a trade-mark case, the complaint makes no trade-mark an issue; no trade-marks are offered for comparison; no resemblance between trade-marks is proven; the judgment identifies no trade-marks and the order of the Court orders the discontinuance of no trade-mark. Plaintiff has proven no exclusive right to any trade-mark.

Viewed as an action for unfair competition, the plaintiff has proven no exclusive right to any word; it has proven no secondary meaning as having attached to any word; it has not proven its use of any word in its secondary sense upon its goods; it has not proven any imitation or resemblance between its marks of identification and those of defendant, or any deceptive likeness between its goods as offered upon the market and those of defendant as packed for sale; it has proven no intent to deceive, affirmatively nor inferentially, by a resemblance in the appearance of defendant's goods; it has proven no instance of

mistaken identity of goods, and no similitude calculated to deceive any person; it has proven no loss and no probable loss.

On the other hand the word it claims exclusive right to is a geographical word and is *publici juris*; plaintiff has never used this word as a trade-name, trade-mark, or mark of identification of any of its products. The public know the word only as the name of a Philippine province, and as a kind and quality of tobacco.

CONCLUSION.

We have not thought it necessary to go into anything more than the general features of the argument in the case because the opinion of the Supreme Court below considers in detail the arguments presented at the hearings already had. For the reasons stated in the opinion and those stated above, the case should be dismissed for lack of jurisdiction in this court, or else the judgment of the Supreme Court of the Islands should be affirmed.

Respectfully submitted,

HARRY W. VAN DYKE,
Attorney for Appellee.

EDMUND W. VAN DYKE,
Of Counsel.

43